

41 (c) admixing a carrier and the chemical compound. --

Applicants submit herewith a marked up version of the amendment attached hereto as **Exhibit A**.

REMARKS

Claims 209, 214, 218-220, and 222-228 were pending in the subject application. By this Amendment, applicants have amended claim 222 without disclaimer or prejudice to applicants' right to patent protection commensurate in scope with their invention. Accordingly, upon entry of this Amendment, claims 209, 214, 218-220, and 222-228 as amended will be pending and under examination.

Applicants maintain that this Amendment raises no issue of new matter and is fully supported by the specification as filed. Specifically, support for the amendment to claim 222 may be found in the specification, as originally-filed, on page 38, lines 14-17; page 39, lines 14-17; page 40, lines 1-4; page 42, lines 11-14; page 45, lines 28-33; page 66, lines 8 through page 67, line 2; and page 68, line 22 through page 69, line 24. Accordingly, applicants respectfully request that this Amendment be entered.

1. Rejections Under 35 U.S.C. § 112, First Paragraph

1a. On page 2 of the May 30, 2002 Final Office Action the Examiner rejected claims 222 and 223 under 35 U.S.C. § 112, first paragraph, for allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner stated that applicants' arguments as stated in Paper Number 18 filed by applicants on March 12, 2002 have been fully considered but are not deemed persuasive. The Examiner alleged that although claim 223 does not recite "homolog" or "analog", these terms are encompassed in the claim because 223 depends on claim 222. The Examiner then alleged that although the terms "homolog" or "analog" were well known in the art, it is not disclosed what such a compound would look like. The Examiner further alleged that although applicants point to [¹²⁵I]leptin as a radiolabeled homolog and analog of a compound that binds hOb-Re, the compound also binds the hOb-Re receptor, and so would not allegedly be characterized as a homolog or analog, since the claims as written encompass a compound that binds to the receptor **or** a structural and functional analog or homolog thereof. (Emphasis in original.)

The Examiner concluded that as the claims are written, the structural and functional analog or homolog allegedly would not bind the receptor, and the specification has not adequately disclosed such compounds, nor taught how to use compounds that would not bind.

In response, in an attempt to advance the prosecution of the subject application, but without conceding the correctness of the Examiner's position, applicants have amended claim 222 to, among other things, delete the phrase "or a structural and functional analog or homolog thereof", thereby rendering this portion of the rejection moot.

Accordingly, applicants respectfully request that this basis of the rejection be reconsidered and withdrawn.

1b. On page 4 of the May 30, 2002 Final Office Action the

Examiner further rejected claims 222 and 223 under 35 U.S.C. § 112, first paragraph, for allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner alleged that claims 222 and 223 are rejected for reciting the step "wherein said chemical compound has been recovered free of any soluble polypeptide". The Examiner stated that applicants' arguments as stated in Paper Number 18 filed by applicants on March 12, 2002 have been fully considered but are not deemed persuasive.

The Examiner alleged that in the assays on page 66 for example, membrane preparations are incubated with various compounds that are labeled, and it is the unlabeled ligands that are separated away, leaving the compound that binds to the receptor in the membrane still bound to the membrane. The Examiner then alleged that although soluble polypeptides may be removed, the compound is bound to the membrane, and this is not the method that is encompassed by the claim. The Examiner further alleged that though this and other assays have some type of filtration or separation step, the steps and goals are different from that of claim 222.

The Examiner indicated that the recovery step is not necessary, and the rejection would be withdrawn if step (b) in claim 222 were deleted.

In response, in an attempt to advance the prosecution of the subject application, but without conceding the correctness of the Examiner's position, applicants have amended claim 222 to, among other things, delete previous step (b) as suggested by the Examiner.

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Accordingly, applicants respectfully request that this ground of rejection be reconsidered and withdrawn.

2. Allowable Subject Matter

On page 4 of the May 30, 2002 Final Office Action, the Examiner indicated that claims 209, 214, 218-220 and 224-228 are allowed. The Examiner further indicated that claims 222 and 223 would be allowable if claim 222 were amended to delete "or a structural and functional analog or homolog thereof" and step(b). Applicants thank the Examiner for the indication of allowable subject matter.

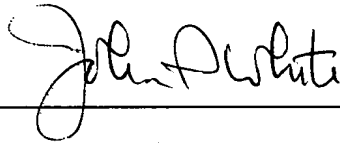
In light of the remarks and amendment made hereinabove, applicants hereby maintain that the subject application is now in condition for allowance and earnestly solicit allowance of the pending claims, namely claims 209, 214, 218-220, and 222-228, as amended.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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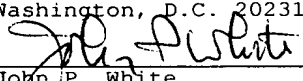
No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Attorney for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

 8/30/02
John P. White Date
Reg. No. 28,678